

- 1 2. Claim 4, line 1, to change "the" to --a-- to eliminate
2 a need for antecedent basis.
- 3 3. Claim 12, line 3, to change "an" to --said-- to make
4 clear that the recitation of "retractor" is the retractor
5 of base claim 1 and not a separate and distinct
6 associated retractor.
- 7 4. Claim 13, line 3, to change "an" to --said-- to make
8 clear that the recitation of "retractor" is the retractor
9 of base claim 1 and not a separate and distinct
10 associated retractor.
- 11 5. Claim 14, line 4, to change "an" to --said-- to make
12 clear that the recitation of "retractor" is the retractor
13 of base claim 1 and not a separate and distinct
14 associated retractor.
- 15 6. Claim 16, line 3, to change "an" to --said-- to make
16 clear that the recitation of "retractor" is the retractor
17 of base claim 1 and not a separate and distinct
18 associated retractor.

19 In view of the amendment made supra to claim 3, line 4,
20 to change "the" to --a--, the amendment made supra to claim
21 4, line 1, to change "the" to --a--, the amendment made supra
22 to claim 12, line 3, to change "an" to --said--, the amendment
23 made supra to claim 13, line 3, to change "an" to --said--,
24 the amendment made supra to claim 14, line 4, to change "an"
25 to --said--, and the amendment made supra to claim 16, line
26 3, to change "an" to --said--, applicant respectfully submits
27 that the Examiner's grounds for the rejection of claims 3, 4,
28 12-14, and 16 under 35 U.S.C. 112, second paragraph, as being
29 indefinite for failing to particularly point out and
30 distinctly claim the subject matter which applicant regards
31 as the invention are no longer applicable and applicant

1 therefore respectfully requests that the Examiner withdraw
2 this rejection.

3 In response to the Examiner's rejection of claims 1-17
4 under 35 U.S.C. 103(a) as being unpatentable over Peterson,
5 regarding claim 1, applicant respectfully draws the Examiner's
6 attention to the fact that the Federal Circuit holds that
7 relevant case law must be relied upon in determining
8 obviousness ipso facto the determination of obviousness is a
9 matter of law, as was decided in In re Deuel, 51 F.3d 1552,
10 1557, 34 USPQ.2d (BNA) 1210, 1214 (Fed. Cir. 1995), where the
11 Court held:

12 "Obviousness is a question of
13 law, which we review de novo,
14 though factual findings
15 underlying the Board's
16 obviousness determination are
17 reviewed for clear error. In
18 re Vaeck, 947 F.2d 488, 493, 20
19 USPQ2d 1438, 1442 (Fed. Cir.
20 1991); In re Woodruff, 919 F.2d
21 1575, 1577, 16 USPQ2d 1934,
22 1935 (Fed. Cir. 1990)."[at
23 1214] [Emphasis added]

24 And, in Richardson-Vicks Inc. v. The Upjohn Co., 122 F.3d
25 1476, 44 USPQ.2d 1181 (Fed. Cir. 1997), where the Court held:

26 "The difficulty with RVI's
27 position is that, although the
28 argument has merit when the
29 issue is purely one of fact, it
30 does not follow when the issue
31 involves a question of law. It
32 is black letter law that the
33 ultimate question of
34 obviousness is a question of
35 law."See Graham v. Deere Co.,
36 383 U.S. 1, 17, 148 USPQ 459,
37 467 (1966) (citing Great A. &
38 P. Tea Co. v. Supermarket
39 Equip. Co., 340 U.S. 147, 155,
40 87 USPQ 303, 309 (1950)); In re

1 Donaldson Co., 16 F.3d 1189,
2 1192, 29 USPQ2d 1845, 1848
3 (Fed. Cir. 1994) (in banc);
4 Texas Instruments Inc. v. Unit
5 States Int'l Trade Comm'n, 988
6 F.2d 1165, 1178, 26 USPQ2d
7 1018, 1028 (Fed. Cir. 1993).
8 And we review that legal
9 question without deference to
10 the trial court. See Gardner
11 V. TEC Sys. Inc., 725 F.2d
12 1338, 1344, 220 USPQ 777, 782
13 (Fed. Cir. 1984) (district
14 court's conclusion on
15 obviousness "is one of law and
16 subject to full and independent
17 review in this court"). "[at
18 1183] [Emphasis added]

19 In the seminal case of Graham v. John Deere Co., 383 U.S.
20 1, 17, 148 USPQ 459, 467, 15 L.Ed. 2d 545, 86 S. Ct. 684
21 (1966), the Supreme Court articulated the requirements for a
22 prima facie holding of obviousness. The Patent Office has
23 since set forth in MPEP 706.02 a three step requirement for
24 establishing a prima facia case of obviousness.

25 The first step requires that the Examiner must set forth
26 the differences in the claim over the applied references. The
27 second step requires that the Examiner must set forth the
28 proposed modification of the reference which would be
29 necessary to arrive at the claimed subject matter. And, the
30 third step requires that the Examiner must explain why the
31 proposed modification would be obvious.

32 The Courts have currently required that in order to
33 satisfy the third step for establishing a prima facia case of
34 obviousness, the Examiner must identify where the prior art
35 provides a motivating suggestion to make the modifications
36 proposed in the second step for establishing a prima facia
37 case of obviousness, as was expressed in the 1992 Federal

1 Circuit Court decision in In re Jones, 958, F.2d 347, 21
2 USPQ.2d 1941, where the Court held:

3 "Contention that one skilled in
4 the herbicidal art would have
5 been motivated to use, with
6 acid commonly known as
7 "dicamba," substituted ammonium
8 salt such as that disclosed in
9 two prior references does not
10 warrant holding that claimed
11 substituted ammonium salt of
12 dicamba for use as herbicide is
13 prima facie obvious, since
14 there is no suggestion for
15 combining disclosures of those
16 references either in references
17 themselves, which are directed
18 to shampoo additives and
19 production of morpholine,
20 respectively, or in knowledge
21 generally available to those
22 skilled in the art."[at
23 1941] [Emphasis added]

24 "The Solicitor points out that,
25 given the breadth of forms of
26 dicamba (free acid, ester, or
27 salt) disclosed by Richter as
28 having herbicidal utility, one
29 of ordinary skill in the art
30 would appreciate that the
31 dicamba group has significance
32 with respect to imparting
33 herbicidal activity to dicamba
34 compounds. Thus, the solicitor
35 contends, one skilled in the
36 art would have been motivated
37 to use, with dicamba,
38 substituted ammonium salts made
39 from a known amine, such as the
40 amine disclosed by Zorayan and
41 Wideman, and would have
42 expected such a salt to have
43 herbicidal activity. Before
44 the PTO may combine the
45 disclosures of two or more

1 prior art references in order
2 to establish prima facie
3 obviousness, there must be some
4 suggestion for doing so, found
5 either in the references
6 themselves or in the knowledge
7 generally available to one of
8 ordinary skill in the art." In
9 re Fine, 837 F.2d 1071, 1074,
10 5 USPQ2d 1596, 1598-99 (Fed.
11 Cir. 1988). We see no such
12 suggestion in Zorayan, which is
13 directed to shampoo additives,
14 nor Wideman, which teaches that
15 the amine used to make the
16 claimed compound is a byproduct
17 of the production of
18 morpholine. Nor does the broad
19 disclosure of Richter fill the
20 gap, for the reasons discussed
21 above."[at 1943-44] [Emphasis
22 added]

23 And, in Arkie Lures, Inc. v. Gene Larew Tackle, Inc., 912
24 F.Supp. 422, 38 USPQ.2d 1300 (W.D.Ark. 1996), where the Court
25 held:

26 "The existence of separate
27 elements of the invention in
28 the prior art is insufficient
29 to establish obviousness,
30 absent some teaching or
31 suggestion in the prior art to
32 combine the elements." [Emphasis
33 added]

34 And, in Gambro Lundia AB v. Baxter Healthcare
35 Corporation, 110 F.3d 1573, 42 USPQ.2d 1378 (Fed. Cir. 1997),
36 where the court held:

37 "Without a suggestion or
38 teaching to combine, a case of
39 obviousness is deficient."
40 [Emphasis added]

41 The Courts further require, however, that even if the
42 prior art may be modified, as suggested by the Examiner, does

1 not make the modification obvious unless the prior art
2 suggests the desirability of the modification, as was
3 expressed in the 1992 Federal Circuit Court decision in In re
4 Fritch, 922, F.2d 1260, 23 USPQ.2d 1780, where the Court held:

5 "Mere fact that prior art may
6 be modified to reflect features
7 of claimed invention does not
8 make modification, and hence
9 claimed invention, obvious
10 unless desirability of such
11 modification is suggested by
12 prior art...."[at 1780]
13 [Emphasis added]

14 "The mere fact that the prior
15 art may be modified in the
16 manner suggested by the
17 Examiner does not make the
18 modification obvious unless the
19 prior art suggested the
20 desirability of the
21 modification. In re Gordon,
22 733 F.2d at 902, 221 USPQ at
23 1127."[at 1783][Emphasis added]

24 And further, the Fritch Court, at 1783, held that the
25 patent applicant may attack the Examiner's prima facie
26 determination as improperly made out and tending to support
27 a conclusion of nonobviousness:

28 "In proceedings before the
29 Patent and Trademark Office,
30 the Examiner bears the burden
31 of establishing a prima facie
32 case of obviousness based upon
33 the prior art...[The Examiner]
34 can satisfy this burden only by
35 showing some objective teaching
36 in the prior art or that
37 knowledge generally available
38 to one of ordinary skill in the
39 art would lead to that
40 individual to combine the
41 relevant teachings of the

1 references. The patent
2 applicant may then attack the
3 Examiner's prima facie
4 determination as improperly
5 made out, or the applicant may
6 present objective evidence
7 tending to support a conclusion
8 of nonobviousness." [Emphasis
9 added]

10 In this same regard, the Examiner's attention is
11 respectfully drawn to the decisions in Heidelberger
12 Druckmaschinen AG v. Hantscho Commercial Products, Inc., 21
13 F.3d 1068, 30 USPQ.2d 1377; In re Fine, 837 F.2d 1071, 5
14 USPQ.2d 1596 (Fed. Cir. 1988); In re Keller, 642 F.2d 413, 208
15 USPQ 871 (CCPA 1981); and In re Merck & Co., Inc., 800 F.2d
16 1091, 231 USPQ 375 (Fed. Cir. 1986).

17 In properly applying the Graham v. John Deere Co. test
18 in light of, inter alia In re Jones and In re Fritch discussed
19 supra, the Examiner must conduct a rigorous examination and
20 analysis of the prior art.

21 Applicant respectfully submits that pursuant to 37 CFR
22 1.111(c), claim 1 discloses the following advantageous
23 distinctive feature that distinguishes over and avoids the
24 prior art:

25 "said leash is retractably
26 connected to said collar by
27 said pair of retractors"
28 [Emphasis added].

29 It was decided in In re Miller, 169 USPQ 597 (CCPA 1971)
30 that each and every limitation, inter alia that discussed
31 supra, must be met in determining patentability:

32 "All words in a claim must be
33 considered in judging the
34 patentability of that claim
35 against the prior art." [at
36 600] [Emphasis added]

1 In this same regard, the Examiner's attention is
2 respectfully directed to the decisions in In re Fuetterer, 138
3 USPQ 217 (CCPA 1963); and In re Ludke and Sloan, 169 USPQ 563
4 (CCPA 1971).

5 The advantages of the advantageous distinctive feature
6 of claim 1 discussed supra include:

- 7 1. The leash can be used for "directional training" of
8 the pet because of the pair of retractors and the
9 leash extending from the pair of retractors the
10 leash is formed into two portions, one extending
11 from the right side of the neck of the pet and the
12 other extending from the left side of the neck of
13 the pet, i.e., the leash functions like the reins
14 of a horse, e.g., when one requires the pet to turn
15 right, one merely pulls the right portion of the
16 leash which thereby directs the pet to go right,
17 and the same can be done for the left.
- 18 2. The collar does not have to be removed and reversed
19 on the pet for left or right hand walkers.

20 Even though the advantages discussed throughout the
21 instant amendment may not have been disclosed and discussed
22 specifically in the specification of the patent application
23 as it was originally filed, they still must be relied upon as
24 evidence of patentability, as was decided in In re Chu, 66
25 F.3d 292, 36 USPQ.2d 1089 (Fed. Cir. 1995), where the Court
26 held:

27 "Board of Patent Appeals and
28 Interferences erred, in
29 upholding obviousness rejection
30 of applicant's claims, by
31 concluding that claims'
32 disclosure was matter of
33 "design choice," and that the
34 applicant's evidence and

1 arguments to contrary are not
2 present in specification and
3 are therefore unpersuasive,
4 since board is required to
5 consider totality of record and
6 is not free to disregard
7 evidence and arguments
8 presented by applicants, and
9 since there is no support for
10 proposition that evidence
11 and/or arguments traversing 35
12 USC 103 rejection must be
13 contained within specification,
14 given that obviousness is
15 determined by totality of
16 record including, in some
17 instances most significantly,
18 evidence and arguments
19 proffered during give-and-take
20 of ex parte patent
21 prosecution." [at 1090]
22 [Emphasis added]

23 "Because the Board was required
24 to consider the totality of the
25 record, the Board was not free
26 to disregard the evidence and
27 arguments presented by Chu in
28 response to the obviousness
29 rejection. Additionally, the
30 Board erred in apparently
31 requiring Chu's evidence and
32 arguments responsive to the
33 obviousness rejection to be
34 within his specification in
35 order to be considered. To
36 require Chu to include evidence
37 and arguments in the
38 specification regarding whether
39 placement of the SCR catalyst
40 in the bag retainer was a
41 matter of "design choice" would
42 be to require patent applicants
43 to divine the rejections the
44 PTO will proffer when patent
45 applications are filed." [at
46 1094] [Emphasis added]

1 "We have found no cases
2 supporting the position that a
3 patent applicant's evidence
4 and/or arguments traversing a
5 § 103 rejection must be
6 contained within the
7 specification. There is no
8 logical support for such a
9 proposition as well, given that
10 obviousness is determined by
11 the totality of the record
12 including, in some instances,
13 most significantly, the
14 evidence and arguments
15 proffered during the give-and-
16 take of ex parte patent
17 prosecution." [at 1095] [Emphasis
18 added]

19 And, even though the present invention may be considered
20 simple and accomplishes only a small but genuine improvement
21 by some is not sufficient reason to deny it patent protection,
22 as was decided in Schnell et al. v. The Allbright-Nell Company
23 et al., 146 USPQ 322 (Court of Appeals, Seventh Circuit 1965),
24 where the Court held:

25 "Device seems simple...in light
26 of patentee's teaching, but it
27 evidently was not...at time of
28 invention; those working in the
29 field did not accomplish
30 patentee's results; that fact
31 supports conclusion that
32 patentee achieved patentable
33 invention." [at 322] [Emphasis
34 added]

35 "This now seems simple...in the
36 light of the Schnell teaching,
37 but it was evidently not at
38 all...at the time of the
39 invention. Those working in
40 the field did not accomplish
41 Schnell's results. That fact
42 supports the conclusion that

1 Schnell achieved patentable
2 inventions. Pyle Nat. Co. v.
3 Lewin, 7 Cir., 1937, 92 F.2d
4 628, 630, 35 USPQ 40, 42."[at
5 324] [Emphasis added]

6 The Board of Appeals expressed the same concept when it
7 held in Ex parte Grasenick and Gessner, 158 USPQ 624 (Patent
8 Office Board of Appeals 1967), that:

9 "Improvement over prior art,
10 even though it be simple is
11 patentable...." [Emphasis
12 added] [at 624]

13 "This rejection is in error.
14 An improvement over the prior
15 art, even though it be simple
16 ...is patentable...." [at 624]
17 [Emphasis added]

18 Attention is also respectfully directed in this regard
19 to the decisions in Mercantile National Bank of Chicago et al.
20 v. Quest, Inc. et al., DC.N.D. Indiana, 166 USPQ 517; In re
21 Shelby, 136 USPQ 220, and In re Irani and Moedritzer, 166 USPQ
22 24.

23 The Examiner has relied upon St. Regis Paper Co. v. Bemis
24 Co., 193 USPQ 8 for the rejection of claim 1. Applicant has
25 reviewed this case and finds no support therein for the
26 Examiner's statement made at page 3, paragraph 8, lines 3-5
27 of the first Office Action:

28 "...it has been held that mere
29 duplication of the essential
30 working parts of a device
31 involves only routine skill in
32 the art." [Emphasis added]

33 The configuration of the advantageous distinctive feature
34 of claim 1 discussed supra is not merely a so-called
35 duplication of the essential working parts of a device, but
36 is significant and of critical importance. It therefore must

1 be considered in determining patentability, as was decided in
2 In re Dailey and Eilers, 149 USPQ 47 (CCPA 1976), where the
3 Court held that the configuration of a device must be
4 considered in determining patentability if the configuration
5 is significant:

6 "Appellants have presented no
7 argument which convinces us
8 that the particular
9 configuration of their
10 container is significant or is
11 anything more than one of
12 numerous configurations a
13 person of ordinary skill in the
14 art would find obvious for the
15 purpose of providing mating
16 surfaces in the collapsed
17 container of Matzen. See
18 Graham v. John Deere Co., 383
19 U.S. 1, 148 USPQ 459."
20 [Emphasis added]

21 The configuration of the advantageous distinctive feature
22 of claim 1 discussed supra, i.e., "said leash is retractably
23 connected to said collar by said pair of retractors" [Emphasis
24 added], is significant and of critical importance since it,
25 as discussed supra:

26 1. Allows the leash to be used for "directional
27 training" of the pet because of the pair of
28 retractors and the leash extending from the pair of
29 retractors the leash is formed into two portions,
30 one extending from the right side of the neck of
31 the pet and the other extending from the left side
32 of the neck of the pet, i.e., the leash functions
33 like the reins of a horse, e.g., when one requires
34 the pet to turn right, one merely pulls the right
35 portion of the leash which thereby directs the pet
36 to go right, and the same can be done for the left.

1 2. Eliminates the collar from having to be removed and
2 reversed on the pet for left or right hand walkers.

3 Regarding claim 4, applicant respectfully submits that
4 the Examiner has taken facts beyond the record by stating at
5 page 3, paragraph 11, lines 4-6 of the first Office Action a
6 statement that is contrary to the PTO policy in MPEP 706.02(a)
7 directing Examiners never to overlook the importance of
8 allowing claims that properly define patentable subject
9 matter:

10 "...the equivalence of hook and
11 loop fasteners and buckles for
12 their use in the fastening art
13 and the selection of known
14 equivalents to buckles would be
15 within the level of ordinary
16 skill in the art." [Emphasis
17 added]

18 It is improper, if not inequitable, for the Examiner to
19 rely on this fact for evidence of the rejection, as was
20 decided in In re Howard, 394 F.2d 869 (CCPA 1968), where the
21 Court held:

22 "I do not see how, without any
23 evidence, we can use the
24 doctrine of judicial notice to
25 find that a system exists which
26 anticipates that of the
27 application or is nearly like
28 it as to make the application
29 an obvious variation...[.]
30 Without some concrete evidence
31 (of which there is none) I do
32 not think that it is possible
33 to find that the system of this
34 application is old or that it
35 is obvious under Section
36 103." [at 872] [Emphasis added]

37 And, in In re Ahlert, 165 USPQ 418, 420 (CCPA 1970),
38 where the Court held:

1 "Facts beyond the record should
2 not be evidence upon which a
3 rejection is based." [Emphasis
4 added]

5 Furthermore, the Examiner is not obligated to find such
6 a rejection simply to be able to reject every claim in the
7 application. The hook and loop fasteners of claim 4 are not
8 the equivalent of the buckle of Peterson. The test for
9 equivalence include the following factors:

- 10 1. The prior art element performs the identical function
11 specified in the claim in substantially the same way, and
12 produces substantially the same results as the
13 corresponding element specified in the claim. Kemco
14 Sales, Inc. v. Control Papers Co., 54 USPQ2d 1308, 1315
15 (Fed. Cir. 2000); and Odetics, Inc. v. Storage Tech. 185
16 F.3d 1259, 1267, 51 USPQ2d 1225, 1229-30 (Fed. Cir.
17 1999).
- 18 2. A person of ordinary skill in the art would have
19 recognized the interchangeability of the element shown
20 in the prior art for the corresponding element specified
21 in the claim. Al-Site Corp. v. VSI Int'l, Inc., 174 F.3d
22 1308, 1316, 50 USPQ2d 1161, 1165 (Fed. Cir. 1999);
23 Chiuminatta Concrete Concepts, Inc. v. Cardinal, 145 F.3d
24 1303, 1309, 46 USPQ2d 1752, 1757 (Fed. Cir. 1998); and
25 Lockheed Aircraft Corp. v. United States, 553 F.2d 69,
26 83, 193 USPQ 449, 461 (Ct. Cl. 1977).
- 27 3. There are insubstantial differences between the prior art
28 element and the corresponding element specified in the
29 claim. IMS Technology, Inc. v. Haas Automation, Inc.,
30 206 F.3d 1422, 1436, 54 USPQ.2d 1129, 1138 (Fed. Cir.
31 2000); Valmont Indus. v. Reinke Mfg. Co., 983 F.2d 1039,
32 1043, 25 USPQ2d 1451, 1455 (Fed. Cir. 1993).

1 4. The prior art element is a structural equivalent of the
2 corresponding element specified in the claim. In re
3 Bond, 910 F.2d 831, 833, 15 USPQ2d 1566, 1568 (Fed. Cir.
4 1990).

5 5. It would have been obvious to one of ordinary skill in
6 the art at the time of the invention to substitute the
7 claimed element for that described in the prior art
8 reference. In re Brown, 459 F.2d 531, 535, 173 USPQ 685,
9 688 (CCPA 1972).

10 Pursuant to In re Mulder, 716 F.2d 1542, 1549, 219 USPQ
11 189, 196 (Fed. Cir. 1983), applicant will apply the five
12 factors discussed supra to the case at hand to show that the
13 buckle of Peterson is not an equivalent of the hook and loop
14 fasteners of claim 4.

15 1. THE BUCKLE OF PETERSON DOES NOT PERFORM THE
16 IDENTICAL FUNCTION IN SUBSTANTIALLY THE SAME
17 WAY NOR DOES IT PRODUCE SUBSTANTIALLY THE SAME
18 RESULTS AS THE HOOK AND LOOP FASTENERS OF CLAIM 4.

19 The hook and loop fasteners of claim 4 facilitate
20 affixing and unaffixing the collar relative to the pet by
21 merely requiring the lowering and raising of one end of the
22 collar having one portion of the hook and loop fasteners
23 thereon onto and off of the other end of the collar having the
24 other portion of the hook and loop fasteners thereon,
25 respectively, while the buckle of Peterson does not facilitate
26 the affixing and unaffixing of the collar relative to the pet
27 by requiring insertion of one end of the collar through a ring
28 on the other end of the collar and the insertion of a pin of
29 the ring into a hole in the first end of the collar. Thus,
30 the buckle of Peterson does not perform the identical function
31 in substantially the same way nor does it produce

1 substantially the same results as the hook and loop fasteners
2 of claim 4.

3 2. A PERSON OF ORDINARY SKILL IN
4 THE ART WOULD NOT HAVE RECOGNIZED THE
5 INTERCHANGEABILITY OF THE BUCKLE OF PETERSON
6 FOR THE HOOK AND LOOP FASTENERS OF CLAIM 4

7 Hook and loop fasteners provide for finite positioning
8 of one end of the collar onto the other end of the collar
9 during attachment by virtue of where the first portion of the
10 hook and loop fasteners are placed upon the other portion of
11 the hook and loop fasteners, which allows the collar to fit
12 perfectly around any sized pet's neck, whereas a buckle only
13 provides for predetermined positioning of one end of the
14 collar relative to the other end of the collar during
15 attachment by virtue of where the holes in the collar are
16 placed. Thus, a person of ordinary skill in the art would not
17 have recognized the interchangeability of the buckle of
18 Peterson for the hook and loop fasteners of claim 4.

19 3. THERE ARE SUBSTANTIAL DIFFERENCES
20 BETWEEN THE BUCKLE OF PETERSON AND
21 THE HOOK AND LOOP FASTENERS OF CLAIM 4

22 The buckle of Peterson comprises a ring with a pin
23 disposed on one end of the collar and a series of holes in the
24 other end of the collar wherein the other end of the collar
25 is inserted through the ring and the pin of the ring is
26 inserted into a required hole, whereas the hook and loop
27 fasteners of claim 4 merely comprise one portion thereof
28 disposed on one end of the collar and a mating portion thereof
29 disposed on the other end of the collar. Thus, there are
30 substantial differences between the buckle of Peterson and
31 the hook and loop fasteners of claim 4.

32 4. THE BUCKLE OF PETERSON IS NOT A
33 STRUCTURAL EQUIVALENT OF THE HOOK
34 AND LOOP FASTENERS OF CLAIM 4.

1 See paragraph 3 supra. Thus, the buckle of Peterson is
2 not a structural equivalent of the hook and loop fasteners of
3 claim 4.

4 5. IT WOULD NOT HAVE BEEN OBVIOUS TO ONE OF
5 ORDINARY SKILL IN THE ART AT THE TIME OF THE
6 INVENTION TO SUBSTITUTE THE HOOK AND LOOP
7 FASTENERS OF CLAIM 4 FOR THE BUCKLE OF PETERSON

8 One purpose of the buckle of Peterson is to add weight
9 so that the buckle is positioned on the underside of the neck
10 of the pet so that the leash handle is positioned on the top
11 of the neck of the pet as discussed at numerous occurrences
12 throughout Peterson, for example:

13 "...the combined weight of
14 retractor mechanism and buckle
15 keeps these parts on the
16 underside of the neck and holds
17 the leash handle on top of the
18 neck."[at col. 1, lines 41-44
19 of Peterson][Emphasis added];

20 "...the combined weight of
21 buckle 11, tethering 13 and
22 retractor mechanism 15
23 containing most of the length
24 of leash 16 far exceeds the
25 combined weight of guide ring
26 18 and handle 20. Thus when
27 the leash is in retracted
28 position as shown in solid
29 lines in FIG. 2 the relative
30 heavier parts 11, 13 and 15
31 gravitate to the under side of
32 the animal's neck placing the
33 handle 20 in its most
34 convenient position for
35 grasping, on top of the
36 neck."[at col. 2, lines 37-45
37 of Peterson][Emphasis added];
38 and

39 "...the weight of said buckle
40 and retractor mechanism exceeds

1 the weight of said guide ring
2 and handle sufficiently to hold
3 said handle in a position on
4 top of the neck of the
5 animal."[at claim 3, lines 1-4
6 of [Peterson][Emphasis added].

7 Being made of fabric, hook and loop fasteners are
8 extremely light and as such will not provide the needed weight
9 that the buckle of Peterson provides for the purpose of
10 positioning the buckle on the underside of the neck of the
11 pet. Therefore, the hook and loop fasteners of claim 4 cannot
12 accomplish the positioning purpose the buckle of Peterson and
13 therefore cannot be substituted for the buckle of Peterson.
14 Thus, it would not have been obvious to one of ordinary skill
15 in the art at the time of the invention to substitute the hook
16 and loop fasteners of claim 4 for the buckle of Peterson.

17 Furthermore, since substituting the hook and loop
18 fasteners of claim 4 for the buckle of Peterson would prevent
19 the device of Peterson from functioning in its intended manner
20 as discussed supra, i.e., it would not add the needed weight
21 that the buckle creates to be positioned on the underside of
22 the neck of the pet, such a substitution cannot be used for
23 a holding of obviousness as was decided in the Board of
24 Appeals decision in Ex parte Weber, 154 USPQ 491, where the
25 Board refused to uphold a rejection on obviousness because the
26 rearrangement of the prior-art device prevented the device
27 from functioning in the intended manner:

28 "Rearrangement of prior machine
29 would so alter its construction
30 and mode of operation that it
31 would not function in its
32 intended manner; obviousness of
33 proposed changes is not derived
34 from cited prior art but from
35 applicant's disclosure."
36 [Emphasis added]

1 In view of the many discussions supra, if the Examiner
2 still maintains the rejection of claim 4, applicant
3 respectfully requests that the Examiner provide a reference
4 that teaches the limitation of claim 4, as required by MPEP
5 706.02(a) and In re Ahlert discussed supra; In re Kaplan, 229
6 USPQ 678, 683 (CAFC 1986); and In re Newell, 13 USPQ.2d 1248
7 (CAFC 1989), where the Court held:

8 "Without such concrete evidence
9 neither the applicant nor the
10 Examiner can make a proper
11 determination of the state of
12 the art or the issues relevant
13 to either anticipation or
14 obviousness, nor can the
15 applicant fairly judge whether
16 the prior art discloses the
17 claimed invention, is capable
18 of being combined with the
19 other references, or is in an
20 analogous field of art."
21 [Emphasis added]

22 Or an affidavit by the Examiner detailing the Examiner's
23 knowledge as one of ordinary skill in the art to which the
24 present invention pertains affirming that "...the equivalence
25 of hook and loop fasteners and buckles for their use in the
26 fastening art and the selection of known equivalents to
27 buckles would be within the level of ordinary skill in the
28 art."[Emphasis added], as required by 37 CFR 1.107(b), where
29 it is ruled that:

30 "When a rejection in an
31 application is based on facts
32 within the personal knowledge
33 of an employee of the Office,
34 the data shall be as specific
35 as possible, and the reference
36 must be supported, when called
37 for by the applicant, by the
38 affidavit of such employee, and
39 such affidavit shall be subject

1 to contradiction or explanation
2 by the affidavits of the
3 applicant and other persons."
4 [Emphasis added]

5 Regarding claim 6, the Examiner has relied upon In re
6 Japiske, 86 USPQ 70 for the rejection thereof. Applicant has
7 reviewed this case in view of the Examiner's statement made
8 at page 3, paragraph 13, lines 5-7 of the first Office Action:

9 "...it has been held that
10 rearranging parts of an
11 invention involves only routine
12 skill in the art." [Emphasis
13 added]

14 What the Japiske Court held was that rearranging parts
15 of an invention involves only routine skill in the art, if and
16 only if, the operation of the invention is not changed, as
17 discussed at 73 of In re Japiske where it is disclosed:

18 "...there would be no invention
19 in shifting the starting switch
20 disclosed by Cannon to a
21 different position since the
22 operation of the device would
23 not thereby be modified."
24 [Emphasis added]

25 Applying the decisional law of the Japiske Court
26 discussed supra to the case at hand, it is revealed that each
27 end of the leash being operatively connected to the pair of
28 retractors, respectively, would modify the operation of the
29 device of Peterson which has only one end of the leash
30 connected to one retractor for the reasons presented in the
31 arguments regarding claim 1 supra and as rehashed infra.

32 The device of Peterson having only one end of the leash
33 connected to the one retractor cannot allow the leash to be
34 used for "directional training" of the pet because of the
35 leash extending from only one position on the neck of the pet,
36 i.e., the leash cannot function like the reins of a horse, as

1 shown in FIGS. 1 and 2 of Peterson and as discussed at col.
2 3, lines 6-9 of Peterson where it is disclosed:

3 "As shown in FIGS 1 and 2 the
4 leash projects from the right
5 side of the animal. By
6 reversing the collar the leash
7 will project to the left side,
8 if desired." [Emphasis added]

9 The device of Peterson having only one end of the leash
10 connected to the one retractor requires the collar to be
11 removed and reversed on the pet for left or right hand
12 walkers.

13 Regarding claims 11-17, applicant respectfully submits
14 that the Examiner has again taken facts beyond the record by
15 stating at page 4, paragraph 18, lines 4-6 of the first Office
16 Action a statement that again is contrary to the PTO policy
17 in MPEP 706.02(a) directing Examiners never to overlook the
18 importance of allowing claims that properly define patentable
19 subject matter:

20 "...the equivalence of
21 retracting mechanisms for their
22 use in the tethering art and
23 the selection of many known
24 equivalents to retracting
25 mechanisms would be within the
26 level of ordinary skill in the
27 art." [Emphasis added]

28 Again, it is improper, if not inequitable, for the
29 Examiner to rely on this fact for evidence of the rejection,
30 as was decided in In re Howard and In re Ahlert discussed
31 supra.

32 Furthermore, again the Examiner is not obligated to find
33 such a rejection simply to be able to reject every claim in
34 the application. The ratchet retracting mechanisms of the
35 pertinent claims of claims 11-17 are not the equivalent of the

1 retracting mechanism of Peterson. Pursuant to In re Mulder
2 discussed supra, applying the test presented supra for the
3 arguments of claim 4 to the pertinent claims of claims 11-17,
4 applicants will show that the retractor mechanism of Peterson
5 is not an equivalent of the ratchet retractor mechanisms of
6 the pertinent claims of claims 11-17.

7 1. THE RETRACTOR MECHANISM OF PETERSON DOES
8 NOT PERFORM THE IDENTICAL FUNCTION IN SUBSTANTIALLY
9 THE SAME WAY NOR DOES IT PRODUCE SUBSTANTIALLY THE
10 SAME RESULTS AS THE RATCHET RETRACTOR MECHANISMS
11 OF THE PERTINENT CLAIMS OF CLAIMS 11-17.

12 The ratchet retractor mechanisms of the pertinent claims
13 of claims 11-17 allow the leash to be extended from the pair
14 of retractors to any length and be maintained thereat, while
15 the retractor mechanism of Peterson does not allow the leash
16 to be extended from the retractor to any length and be
17 maintained thereat. Thus, the retractor mechanism of Peterson
18 does not perform the identical function in substantially the
19 same way nor does it produce substantially the same results
20 as the ratchet retractor mechanisms of the pertinent claims
21 of claims 11-17.

22 2. A PERSON OF ORDINARY SKILL IN THE ART WOULD NOT HAVE
23 RECOGNIZED THE INTERCHANGEABILITY OF THE RETRACTING
24 MECHANISM OF PETERSON FOR THE RATCHET RETRACTING
25 MECHANISMS OF THE PERTINENT CLAIMS OF CLAIMS 11-17

26 Ratchet retracting mechanisms provide continual control
27 of the pet by locking the leash at any desired length so that
28 the pet cannot dart off and extend the leash, whereas a non-
29 ratchet retractor mechanism cannot provide continual control
30 of the pet by not locking the leash at any desired length so
31 that the pet can dart off and extend the leash. Thus, a
32 person of ordinary skill in the art would not have recognized
33 the interchangeability of the retracting mechanism of Peterson

1 for the ratchet retracting mechanisms of the pertinent claims
2 of claims 11-17.

3 3. THERE ARE SUBSTANTIAL DIFFERENCES
4 BETWEEN THE RETRACTING MECHANISM OF PETERSON
5 AND THE RATCHET RETRACTING MECHANISMS OF
6 THE PERTINENT CLAIMS OF CLAIMS 11-17

7 The retracting mechanism of Peterson does not comprise
8 a rack and a pawl for locking the leash at any desired length,
9 whereas the ratchet retracting mechanisms of the pertinent
10 claims of claims 11-17 comprise racks and pawls, wherein the
11 pawls operatively connect to the racks, respectively. Thus,
12 there are substantial differences between the retracting
13 mechanism of Peterson and the ratchet retracting mechanisms
14 of the pertinent claims of claims 11-17.

15 4. THE RETRACTING MECHANISM OF PETERSON IS NOT A
16 STRUCTURAL EQUIVALENT OF THE RATCHET RETRACTING
17 MECHANISMS OF THE PERTINENT CLAIMS OF CLAIMS 11-17

18 See paragraph 3 supra. Thus, the retracting mechanism
19 of Peterson is not a structural equivalent of the ratchet
20 retracting mechanisms of the pertinent claims of claims 11-17.

21 In view of the many discussions supra, if the Examiner
22 still maintains the rejection of claims 11-17, applicant
23 respectfully requests that the Examiner provide a reference
24 that teaches the limitations of claims 11-17, as required by
25 MPEP 706.02(a), In re Ahlert, In re Kaplan, and In re Newell
26 discussed supra, or an affidavit by the Examiner detailing the
27 Examiner's knowledge as one of ordinary skill in the art to
28 which the present invention pertains affirming that "...the
29 equivalence of retracting mechanisms for their use in the
30 tethering art and the selection of nay known equivalents to
31 retracting mechanisms would be within the level of ordinary
32 skill in the art." [Emphasis added], as required by 37 CFR
33 1.107(b) discussed supra.

1 Applicant has provided clear and convincing evidence that
2 neither Peterson nor for that matter any of the references
3 cited by the Examiner accomplish applicant's result of
4 providing an efficient retractable tether for a pet that,
5 inter alia:

6 1. Can be used for "directional training" of the pet
7 because of the pair of retractors and the leash
8 extending from the pair of retractors the leash is
9 formed into two portions, one extending from the
10 right side of the neck of the pet and the other
11 extending from the left side of the neck of the
12 pet, i.e., the leash functions like the reins of a
13 horse, e.g., when one requires the pet to turn
14 right, one merely pulls the right portion of the
15 leash which thereby directs the pet to go right,
16 and the same can be done for the left.

17 2. Does not have to be removed and reversed on the pet
18 for left or right hand walkers.

19 Therefore a holding of obviousness cannot be made out,
20 as was decided by the Board of Appeals in Ex parte Tanaka,
21 Marushima and Takahashi, 174 USPQ 38, where the Board held:

22 "Claims are not rejected on the
23 ground that it would be obvious
24 to one of ordinary skill in the
25 art if the prior art devices do
26 not accomplish applicant's
27 result."[Emphasis added]

28 And, in In re Wright, 122 USPQ 522 (1959), where the
29 Court held:

30 "...the mere aggregation of old
31 elements that did not perform
32 a different function is not a
33 patentable invention, but that
34 a novel combination of old
35 elements which cooperate with

1 each other to produce a new or
2 useful result or a substantial
3 increase in efficiency is
4 patentable."[Emphasis added]

5 And, further in the en banc decision in In re Dillon, 919
6 F.2d 688, 692 (Fed. Cir. 1990), where the Court held:

7 "...a prima facie case of
8 obviousness requires that the
9 prior art suggest the claimed
10 compositions' properties and
11 the problem the applicant
12 attempts to solve."[Emphasis
13 added]

14 In this same regard, the Examiner's attention is
15 respectfully directed to the decisions in In re Halleck, 164
16 USPQ 647 (CCPA 1970); and Kockum Industries, Inc. v. Salem
17 Equipment, Inc., 175 USPQ 81 (9th Cir. 1972).

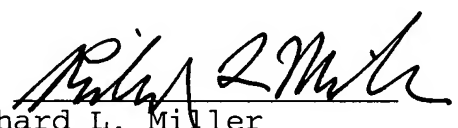
18 In light of, inter alia In re Deuel, Richardson-Vicks
19 Inc. v. The Upjohn Co., the Graham v. John Deere Co. test in
20 light of, inter alia MPEP 706.02, In re Jones, Arkie Lures,
21 Inc. v. Gene Larew Tackle, Inc., Gambro Lundia AB v. Baxter
22 Healthcare Corporation, In re Fritch, Heidelberger
23 Druckmaschinen AG v. Hantscho Commercial Products, Inc., In
24 re Fine, In re Keller, and In re Merck & Co., Inc., In re
25 Miller, In re Fuetterer, In re Ludke and Sloan, In re Chu,
26 Schnell et al. v. The Allbright-Nell Company et al., Ex parte
27 Grasenick and Gessner, Mercantile National Bank of Chicago et
28 al. v. Quest, Inc. et al., In re Shelby, In re Irani and
29 Moedritzer, St. Regis Paper Co. v. Bemis Co., In re Dailey and
30 Eilers, MPEP 706.02(a), In re Howard, In re Ahlert, Kemco
31 Sales. Inc. v. Control Papers Co., Odetics, Inc. v. Storage
32 Tech, Al-Site Corp. v. VSI Int'l, Inc., Chiuminatta Concrete
33 Concepts, Inc. v. Cardinal, Lockheed Aircraft Corp. v. United
34 States, IMS Technology, Inc. v. Haas Automation, Inc., Valmont

1 Indus. v. Reinke Mfg. Co., In re Bond, In re Brown, In re
2 Mulder, Ex parte Weber, In re Kaplan, In re Newell, 37 CFR
3 1.107(b), In re Japiske, Ex parte Tanaka, Marushima and
4 Takahashi, In re Wright, In re Dillon, In re Halleck, and
5 Kockum Industries, Inc. v. Salem Equipment, Inc., discussed
6 supra, pursuant to In re Fritch at 1783 discussed supra,
7 applicant attacks the Examiner's prima facie determination as
8 being improperly made out and tending to support a conclusion
9 of nonobviousness.

10 In view of the arguments presented supra, applicant
11 respectfully submits that the Examiner's grounds for the
12 rejection of claims 1-17 under 35 U.S.C. 103(a) as being
13 unpatentable over Peterson are no longer applicable and
14 applicant therefore respectfully requests that the Examiner
15 withdraw this rejection.

16 Respectfully submitted,

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BY: 
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